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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/830,175	04/22/2004	David I. Houlding	92717-00363USPT	7727
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WINSTEAD PC P.O. BOX 50784 DALLAS, TX 75201			EXAMINER HARRELL, ROBERT B	
			ART UNIT	PAPER NUMBER
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			12/23/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/830,175	<b>Applicant(s)</b> HOULDING ET AL.	
	<b>Examiner</b> Robert B. Harrell	<b>Art Unit</b> 2442	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>see attached Office Action</u> .       |

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1. Claims 1-26 are presented for examination.
2. All of the applicant's arguments to date have been fully considered and found persuasive thus resulting in vacating all pending rejections, and grounds for those rejection, to date, except as for those outlined below which continue and/or are hereby presented.
3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
4. The applicant should always use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks <sup>TM</sup>, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., ***provide proper antecedent basis for "the" and "said" within each claim***) with each claim ending in a period. Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.
5. 35 U.S.C. 101 reads as follows:

***Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.***

6. **Claims 1-26 are rejected under 35 U.S.C. 101** because the claimed invention, in light of the specification, encompasses non-statutory subject matter since such reads on (encompass) software or program per se' (In re Beauregard (CAFC) 35 USPQ2d 1383) and MPEP 2106 (New EXAMINATION GUIDELINES FOR COMPUTER-RELATED INVENTIONS). Even though drafted as "A method", each of the recited elements encompass their software or program per se' equivalent; thus, the whole of the method encompasses pure software or program per se'; unlike "A method executing on a **hardware**". Also, while a hardware device claim, with functional acts, may inherently encompass a corresponding method, the same does not hold in the reverse since a corresponding method is broader in scope and can encompass a scope void of any hardware. As for the system claims, such encompass only software or program per se' equivalents (i.e., a client (customer) such as a Netscape Web Browser and/or a server such as Apache are each software devices and yet phrased as a client and a server); unlike "A **hardware** system"; the applicant is reminded that an Operating **System** is software and/or program per se'.

7. The applicant's 16 December 2008 response argued the previous Office Action's rejection under 35 U.S.C. 101 in substance by stating the claims stand rejected under 35 U.S.C. § 101 as being directed to unpatentable subject matter. Claim 1 as amended clarifies that *at least one server* provides a framework for creating a customized core product to meet a service need specific to the customer that is not met by the core product. The applicant respectfully submits

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that claim 1 is now more clearly directed to patentable subject matter. The applicant respectfully submits that claims 2-11, at least due to dependency from claim 1, are also directed to patentable subject matter. However, as indicated above, a “server” is not strictly hardware per se’ and does encompass software servers such as, but not limiting the claims thereto, Apache which is (was) a software Web Server. Thus, even in view of the added “server” limitation, the system claims encompass a pure software or program per se’ system.

8. The following is a quotation of the second paragraph of 35 U.S.C 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

9. **Claims 1-26 are rejected under 35 U.S.C 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The scope of meaning of the claim language is not clear since it cannot be clearly ascertained if the claims encompass only hardware, or pure software, or a combination since there is no clear recital of actual hardware.

10. Pronouns such as “its” (claim 1 (last line) for example) fails to clearly recite the antecedent proper noun.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

**A person shall be entitled to a patent unless -**

**(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;**

12. **Claims 1-26 are rejected under 35 U.S.C. 102 (e)** as being anticipated by Crow et al. (United States Patent Number: US 7,334,038 B1).

13. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant’s attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited*

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and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

14. Per claim 1, Crow taught a system (e.g., see Abstract) for at least one of specializing, replacing, and adding services of a service oriented architecture (since the claims calls for “at least one of” only one need be taught by the reference; in this case, such was adding services for a service oriented architecture per the Abstract (line 3)), the system comprising:

- a) a core product (e.g., see Abstract (“minimum service functionality” in line 9)) for utilization by a customer (e.g., see Abstract (“subscriber” in line 10)), the core product being generic in nature and intended for use by more than one customer (e.g., see col. 4 (line 46-et seq.));
- b) at least one server (e.g., see figure 9 (925)), the at least one server providing a framework (e.g., see Abstract (lines 1-2)) for creating a customized core product to meet a service need specific to the customer that is not met by the core product (e.g., see Abstract and col. 7 (line 52 “specific”));
- c) wherein the core product comprises a plurality of existing service implementations (e.g., see Abstract and col. 4 (line 46-et seq.));
- d) wherein the at least one server utilizes the framework to create the customized core product by at least adding a new service implementation (since the claims calls for “at least one of” only one need be taught by the reference; in this case, such was adding services for a service oriented architecture per the Abstract (line 3));
- e) wherein the customized core product (which also encompassed any or all plug-in of figure 9) includes and functionally utilizes the core product in its unaltered form along with any added services (e.g., see Abstract and col.4 (line 46-et seq.)).

15. Per claim 2, claim 3, claim 4, claim 5, claim 6, claim 7, claim 8, claim 9, claim 10, and claim 11, see figure 7 (705) and thus XML was anticipated as such was an inherent part of the Web on the Internet. The service client for requesting was the subscriber indicated above with the service interface being at least an agent, a product so given to the client, covered in figure 1 and detailed in figure 9 (908). As for the "service factory" since services were added, such software that made the addition was the factory and the new service subclassed or replaced with respect to the old service (e.g., see col. 16 (line 66)). Also, when services were added, new implementations, factory, service client and interface were created as these were part of any services in the system as covered in figure 9 which also contained element 908 as a middleware that provided one of the required listed limitations of claim 8 (which states “at least one of”) that had a plurality of middleware therein in figure 9 as 909 constructed from a standard or new configuration (template) per the Abstract and col. 4 (line 46-et seq.).

16. Per claims 12-26, these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above. However, per claim 23 and claim 24, see figure 6 (606) for proxy. Per claim 25, specializing was the same as customizing per col. 6 (line 61) or replaced per col. 16 (line 66).

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**17. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).**

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Thursday from 5:30 am to 2:00 pm.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell, can be reached on (571) 272-3868. The fax phone number for all papers is (571) 273-8300.

20. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

/Robert B. Harrell/  
ROBERT B. HARRELL  
PRIMARY EXAMINER  
GROUP 2442